

REMARKS

In the Office Action, Claims 1-26, 30, 31, and 36-42 were withdrawn from consideration. Claims 27-29 and 32-35 were rejected. Claims 27-31 and 33 have been amended herein.

Amendments to the Claims

Claim 27 was amended to correct a typographical error where the word “with” was missing between the word “bacterium” and the phrase “an effective amount.” This is simply a correction of an obvious typographical error and does not introduce new matter. Also, Claim 27 was amended to correct a clerical error regarding the Markush group terminology. Specifically, the word “or” at the end of the Markush group has been replaced by “and.” Additionally the phrase “group consisting of” has been added. These are simply clerical amendments and do not introduce new matter.

Claims 28 and 29, as well as withdrawn Claims 30 and 31, have been amended to correct a typographic error where the word “gram” was not capitalized. This is simply a typographical correction and does not introduce new matter.

Claim 29 was amended to show that the abbreviation “M.” corresponds to “*Mycobacterium*.” This is simply a clerical correction and does not introduce new matter.

No new matter has been added by these amendments; therefore, examination is requested on the claims as amended herewith.

Regarding the IDS

In the Office Action, the previously submitted IDS List (Form 1449) was initialed and returned. However, references A73, A74, and A76 in the IDS List were not initialed due to the citations being incomplete. As requested by the Examiner, submitted herewith is a new IDS List (Form 1449), which contains the full citations for references A73, A74, and A76. While the Examiner has indicated in the current Office Action that these references were in fact considered, an initialed IDS List indicating this fact is respectfully requested. Since copies of these references have already been submitted, no additional copies are provided herewith.

Objection to the Specification

The Examiner objected to the Specification because the first line, which recites the priority claim, is allegedly improper. The Examiner suggested that “foreign priority” to the PCT application be indicated in the priority claim, specifically suggesting the following language:

“This application claims foreign priority under 35 U.S.C 119(a-d) to PCT/US03/20984 filed July 2, 2003.”

The Examiner’s statement about “foreign priority” to an international application is not correct and Applicants are not required to amend the application as stated by the Examiner. Specifically, the present application is a US National Phase application under 35 U.S.C. § 371 of International Application PCT/US03/20984. As such, the International Application has the same effect, from its filing date, as the US National Phase application. *See* 35 U.S.C. § 363. Because the US National Phase application and the International Application are treated as one in the same, it is not appropriate to speak in terms of “priority” from the application in the US National Stage to the application during its International Stage. M.P.E.P § 1893.03(c) directly speaks to this issue and is reproduced below in relevant part:

A national stage application submitted under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application. *See also* MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a benefit claim under 35 U.S.C. § 120 in the national stage to the international application is inappropriate and may result in the submission being treated as an application filed under 35 U.S.C. § 111(a). *See* MPEP § 1893.03(a). **Accordingly, it is not necessary for the applicant to amend the first sentence(s) of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage.** (Emphasis added)

It is therefore submitted that this objection to the specification is in error and should be withdrawn.

Objection to the Claims

The Examiner objected to Claim 27 as previously amended because it recited “[[d]].” The double brackets were used in the previous amendment to indicate the deletion of material with five or fewer characters, as specifically authorized in 37 C.F.R. §1.121. Thus, this amendment meant that just the paragraph identifier “d” was to be deleted, since only it was

between the double brackets. To summarize this amendment, the paragraph identifier “d” was simply added at an earlier spot in the claim (as indicated by the underlined d) and deleted at this later spot (as indicated by the double bracketed ~~[[d]]~~). The result of this amendment is reflected in the current claim listing.

Rejections to the Claims

35 U.S.C. § 112

Claims 27-29 and 32-35 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Specifically, Claim 27 was rejected due to an obvious typographical error. The word “with” was missing between the word “bacterium” and the phrase “an effective amount.” This typographical error, which would have certainly been recognized by the skilled artisan and, as such, would not have rendered the claim indefinite, has been corrected in the present amendment.

Further, Claim 27 was rejected because it allegedly did not recite proper Markush group language. Applicants have amended Claim 27 to correct a clerical error by replacing the word “or” at the end of the Markush group with the word “and.” Again, this was simply a clarifying amendment. Moreover, the Examiner suggested the use of the phrase “group consisting of,” which is typical language for a Markush group. While Applicants have amended Claim 27 to recite this phrase as suggested by the Examiner, it is noted that the original phrase, *i.e.*, “selected from” without the phrase “group consisting of” is also acceptable terminology. (*See* for example USPTO Training Materials for Examining Patent Applications with Respect to 35 U.S.C. §112, First Paragraph-Enablement of Chemical/Biotechnical Applications. Specifically Examples H and J make clear that the phrase “X selected from A, B, and C” (without the “group consisting of” phrase) is considered proper Markush group language according to the USPTO.)

Claims 28 and 29 were rejected because the word “gram” was not capitalized. While this typographical error has been corrected in the present amendment, the skilled artisan would have certainly known that this term referred to Gram staining and would not have found the claim to be indefinite. Claim 29 was also rejected because of the abbreviation “M.” Given the repeated use of the abbreviation “M” to refer to *Mycobacterium* in the specification, and the common use in the art, this claim would not have been indefinite. Nevertheless, in the present amendment, the abbreviation M. has been written out in the first occurrence as requested by the Examiner.

Finally, Claim 33 was rejected because the term “enhancer” allegedly lacked antecedent basis in Claim 32. Since there was only one term “enhancer” in base Claim 32, the use of “enhancer” without the adjective “permeability” in Claim 33 would not have rendered the original claim indefinite. In any event, Claim 33 has been amended to recite “permeability enhancer.”

In light of the amendments herein, all of the rejections under 35 U.S.C. § 112, second paragraph, are believed to be overcome and should be withdrawn.

35 U.S.C. § 103

Claims 27-29 and 32-35 were rejected under 35 U.S.C. § 103 as allegedly being obvious over White *et al.*, *J. Bacteriology* 182:4028-4034, 2000 (hereinafter “White 1”) in view of White *et al.*, *J. Antimicrobial Chemotherapy* 50:111-114, 2002 (hereinafter “White 2”) and further in view of US Patent 6,319,958 to Johnson *et al.* (hereinafter “Johnson”). Applicants respectfully traverse this rejection. Specifically, the White 2 reference is **not** prior art. Accordingly, White 2 cannot be used by the Examiner in the present rejection and the rejection must therefore be withdrawn.

The White 2 reference was not published before the priority date of the present application. The present application claims the benefit of priority under 35 U.S.C. § 119(e) to U.S. Provisional Application 60/393,680, filed July 2, 2002. This priority claim has been acknowledged by the Examiner in the current Office Action (p. 3, ¶ 7). The White 2 reference was published in the July 2002, volume 50, issue 1 of *J. Antimicrobial Chemotherapy*. The actual date this particular issue published was **July 5, 2002—three days after Applicant’s priority date of July 2, 2002**. Further, on July 2, 2002, only the abstract was available on-line from the publisher. These dates were confirmed by the undersigned who contacted the publisher of the journal, Oxford Journals / Oxford University Press. The undersigned avers that the publisher confirmed the printed publication date of Volume 50, Issue 1 of *J. Antimicrobial Chemotherapy* was July 5, 2002, and the abstract was available on July 2, 2002 (the same day as Applicants priority date). Therefore, because the White 2 reference cited by the Examiner in the present rejection was not publicly available until **after** the priority date afforded the present application (and only the abstract was available on the same day as the priority date), it is not prior art and the rejection based in part on this reference cannot be maintained.

CONCLUSION

Enclosed herewith is payment in the amount of \$425.00, which includes the \$245.00 fee under 37.C.F.R. §1.17(a)(2) for the Two-Month Extension of Time and the \$180.00 fee required under 37 C.F.R. § 1.97(c)(2) for the Information Disclosure Statement. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

BALLARD SPAHR ANDRWES
& INGERSOL, LLP

/Christopher L. Curfman/

Christopher L. Curfman
Registration No. 52,787

BALLARD SPAHR ANDRWES & INGERSOL, LLP
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence – including any items indicated as attached, enclosed, or included – is being transmitted by EFS-WEB on the date indicated below.

/Christopher L. Curfman/

February 13, 2009

Christopher L. Curfman

Date